


Doc Code: AP.PRE.REQ

PTO/SB/33 (07-05)

Approved for use through xx/xx/200x. OMB 0651-00xx
U.S. Patent and Trademark Office, U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number

PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) U02-0161.036	
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)] On _____ Signature _____ Typed or printed name _____		Application Number 10/605,058	Filed 09/05/2003
		First Named Inventor Jonathan DeLine	
		Art Unit 2617	Examiner Khai Minh Nguyen
<p>Applicant requests review of final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p>I am the</p> <p><input type="checkbox"/> applicant/inventor.</p> <p><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.7.1. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</p> <p><input checked="" type="checkbox"/> attorney or agent of record. Registration number 41,329</p> <p><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number If acting under 37 CFR 1.34 _____</p> <p>Note: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below.</p> <p><input type="checkbox"/> * Total of _____ forms are submitted.</p>			
		<p> Signature Gregory A. Stephens Typed or printed name</p> <p>919-286-8000 Telephone number</p> <p>October 31, 2006 Date</p>	

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 C.F.R. 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2

REMARKS IN SUPPORT OF PRE-APPEAL BRIEF

Applicant submits that the current and immediately preceding office actions issued by the Examiner in the present application contain clear errors in the Examiner's rejections as well as omissions of one or more essential elements needed for a prima facie rejection.

The present application contains claims 1-12. However, claims 5 – 8 have been previously canceled. Applicant hereby requests further examination and reconsideration of the application in view of the remarks below.

The Examiner has rejected claims 1-4 and 9-12 as being unpatentable under 35 USC § 103(a) over Lai (U.S. Pub. 2003/0003907) in view of Stenman (U.S. Pat. 6,223,029).

Lai is a remote control system used to monitor and affect the operation of a mobile phone. Lai is limited, however, to exchanging control commands (as opposed to content {audio, video, text message content, etc.}) between itself and a mobile phone. Thus, the device in Lai can receive an indication that a call is incoming to a mobile phone and can even receive and display a caller ID indicator. This can be characterized as control data as opposed to actual content data as claimed in independent claims 1 and 9 of the present invention. Lai's remote control device is then capable of sending control instructions back to the mobile phone causing the mobile phone to take the call, disconnect, transfer the call, etc. (see, ¶ [0040]). This is also evident in ¶s [0028 - 0031] of Lai which describe the transmission of messages containing the *operational status* of the mobile phone. Operational status data is clearly control data as opposed to actual content data.

What Lai cannot do, however, is have the remote control device itself take the call because it does not actually possess a speaker or microphone component despite the Examiners as-

sertion to the contrary. The Examiner has cited ¶s [0002] and [0040] of Lai as disclosing a speaker and microphone within the remote control device. Upon a closer read of ¶s [0002] and [0040] it is evident that Lai was referencing a separate headset that may be linked to the mobile phone not to the remote control device itself. The headset is clearly distinct from the remote control device as described by Lai. The remote control device (40) of Lai is described in ¶ [0030]. Upon review of ¶ [0030] it is clear that neither a speaker nor a microphone are contemplated by the Lai remote control device. Thus, Lai does not teach a remote control device (RCD) having a *speaker for outputting audio signals received from the mobile phone* or a *microphone for receiving audio signals to be transmitted to the mobile phone*.

In sum, Lai teaches a remote control device that can exchange certain control signals with a mobile phone but cannot exchange signals carrying the actual content of a phone call.

The secondary reference cited by the Examiner, Stenman, teaches a single combined mobile phone / remote control device (See, "Title" of Stenman) as opposed to a separate remote control device communicable with a mobile phone as taught by the present invention. Moreover, the Stenman device is mutually exclusively operable as either a mobile phone or a remote controller of peripheral devices. In other words, Stenman can either act as a mobile phone or a remote control.

Contrary to the Examiner's assertion, data signals (such as voice, video or text) received by the mobile phone from a mobile phone network cannot be sent out to a peripheral device by Stenman because Stenman has not disclosed or described a mechanism for integrating the remote control functions with the received signals from the mobile phone network. This is because Stenman and the present invention serve different purposes. Stenman is best described as a combination device that can perform mobile phone functions and remote control functions sepa-

ratclv. The present invention describes and claims a remote control device that is independent of the mobile phone and that can actually receive and re-direct (to peripheral devices) content data from a mobile phone network via the mobile phone. Column 6, lines 17-47 of Stenman and cited by the Examiner describe the process of relaying a telephone call received by the mobile phone over a headset device or placing a call over the PSTN, none of which applies to the present invention.

According to the present invention a mobile phone can receive a photograph over the mobile phone network and relay the photograph to the remote control device which can then re-direct the photograph data to be rendered on a peripheral device such as a television. Similarly, the mobile phone can receive an MP3 audio file over the mobile phone network and relay the MP3 file to the remote control device which can then re-direct the MP3 audio file to be played back on a peripheral device such as a stereo system. Stenman simply does not teach having the remote control device *transmit the data signal received from the mobile phone to a peripheral device* other than directing a received telephone call to a headset. The remote control functions pertaining to peripheral devices of Stenman are enumerated in column 7, lines 2-24, which clearly show that the remote control portion of the combined device are limited to generating instructions for controlling the peripheral devices in response to user input. Instructions are presumed to include raising the volume, changing a channel, pausing a DVD, rewinding a VCR tape or the like. What is not described by Stenman but is claimed by the present invention is re-directing content from a mobile network to a peripheral device.

In addition, the Examiners purported motivation for combining the Lai and Stenman references also fail to meet statutory requirements. The extent of the Examiners motivational statement for combining Lai and Stenman states that the combination would be obvious "in order to

provide{s} a mobile phone {have} having both mobile telephony and remote control functions". The statement is merely conclusory without any real motivation for joining the references. Perhaps the most damaging aspect of the motivational statement is that it completely mischaracterizes the invention. The Examiner states that the combination of Lai and Stenman provides a **mobile phone** that has both mobile telephony and remote control functions. The present invention, however, teaches a **remote control device** (not a mobile phone) that communicates with a mobile phone and also with various peripheral devices in a novel and unobvious fashion to provide for enhanced enjoyment of content related mobile phone functionality and applications. Even if accepted as valid, the Examiners combination of Lai and Stenman and motivational support for such a combination do not teach the invention claimed in the present application.

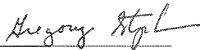
In sum, since Lai does not actually teach some of the elements that the Examiner has credited to Lai and Stenman does not actually teach some of the elements that the Examiner has credited to Stenman, the 35 USC § 103(a) obviousness rejection of Lai (U.S. Pub. 2003/0003907) in view of Stenman (U.S. Pat. 6,223,029) fails to meet its statutory burdens. Moreover, the Examiners purported motivation for combining the Lai and Stenman references also fail to meet statutory requirements.

For the foregoing reasons, the Applicant respectfully submits that all of the claims in the present application are in condition for allowance. Reconsideration and withdrawal of the rejections and allowance of the claims at the earliest possible date are respectfully requested.

Respectfully submitted,

Date: 10/31/2006

Telephone: (919) 286-8000
Facsimile: (919) 286-8199



Gregory Stephens
Attorney for Applicant
Registration No. 41,329
Moore & Van Allen PLLC
430 Davis Drive, Suite 500
Post Office Box 13706
Research Triangle Park, NC 27709